



PTO/SB/33 (07-05)

United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 60282.00047
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number: 09/920,362
on _____	Filed: August 1, 2001
Signature _____	First Named Inventor: Tommi KOISTINEN
Typed or printed Name _____	Art Unit: 2151
	Examiner: Nguyen, Van Kim T.

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 51,091

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


Signature

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February 17, 2006
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Tommi KOISTINEN

Art Unit: 2151

Application No.: 09/920,362

Examiner: Nguyen, Van Kim T.

Filed: August 1, 2001

Attorney Dkt. No.: 60282.00047

For: TONE DETECTION ELIMINATION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 17, 2006

This is a Pre-Appeal Brief Request for Review from the final rejection set forth in an Office Action dated October 19, 2005 ("Office Action"), finally rejecting claims 59-91.

Applicants submit that cited reference fails to disclose or suggest all of the limitations of any of the pending claims and that there is clear error with regard to at least one element of each of the independent claims. A timely Notice of Appeal, and appropriate fee, is submitted herewith.

The cited reference fails to disclose or suggest all of the limitations of pending claims

The claim rejections are set forth in page 2 of the Office Action. The Office Action rejected claims 59-63, 67-70, 72-73, 75, 77-84 and 86-91 under 35 U.S.C. 102(e) as being

anticipated by admitted prior art (APA). Applicants respectfully submit that because the cited reference fails to disclose or suggest all of the elements of the pending claims, there is clear error in the rejection of claims 59-63, 67-70, 72-73, 75, 77-84 and 86-91 under 35 U.S.C. 102.

As a preliminary matter, Applicants note that the APA cannot be considered to be prior art under 35 U.S.C. 102(e), as the APA is not a patent or application by another.

Claim 59, 80, 86, and 90 recite at least in part that first communication device (1) and said first network control device (20; 21) are connected such that a use signal (US) and a control signal (CS) are sent separately to said first network control device (20; 21). Further in the communications system the first network control device (20; 21) and the first interface establishing device (30; 31; 32) are connected such that the use signal (US) and the control signal (CS) are sent separately to the first interface establishing device.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be discussed below, APA fails to expressly or inherently disclose each and every element of the invention. This failure constitutes clear error in rejecting the present claims as being unpatentable over the APA.

Applicants respectfully submit that the APA fails to disclose or suggest all of the features recited in any of the above claims. Specifically, Applicants respectfully submit

that the APA fails to disclose or suggest at least the feature of the first communication device and the first network device are connected such that a use signal and a control signal are sent separately to the first interface establishing device, as recited in claim 59 and similarly recited in claims 80, 86, 88 and 90.

Instead, Figures 1-3 of the specification of the present invention only shows that the use signal and the control signal are transmitted on one line and not separately to the first network establishing device, as claimed in the present invention. As described at least on page 1 line 29 – page 2 line 1 of the specification, Figure 2 merely shows the first network establishing device 3 sending a compressed speech signal USC and the CS to the second network establishing device 5. Further, note that Figure 2 shows that the control signal CS is not sent from the first network control device 3 and the second network control device 3.

Still further, Figure 3, (also labeled “Prior Art”) shows the control signal CS and the use signal US are sent on the same line to the network establishing device. This is further evidenced by the description on page 4 of the specification. In the prior art, the signaling message is converted into a tone signal at the MSC, sent to the gateway, and is then again converted into a signaling message, which may cause disturbances on the use signal.

On the other hand, as clearly shown in Figure 4 and recited in each of claims 59, 80, 86, and 90, and claims dependent thereupon, the use signal US and the control signal CS are transmitted separately to the first network establishing device GW. No such failure is disclosed or suggested in the APA.

Therefore, because APA fails to disclose either implicitly or inherently all of the elements recited in the pending claims, the final rejection of the pending claims constitutes clear error in the final Office Action.

Conclusion

For all of the above noted reasons, it is respectfully requested that the pending anticipation rejections be withdrawn, because the reference does not teach or suggest all of the elements of any of the presently pending claims. Hence the lack of a *prima facie* case of anticipation constitutes clear error as a basis for rejecting the presently pending claims.

Therefore, it is respectfully requested that all of the pending claims be allowed, and that this application be passed to issue.

Respectfully submitted,



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Enclosures: Form PTO/SB/33
Notice of Appeal
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